

## REMARKS AND REQUEST FOR EXTENSION

This paper responds to the Office Action dated August 14, 2003. Please extend the time in which to respond to the Office Action one month, up to and including December 14, 2003. The fee of \$55.00 that is required to affect this extension is enclosed. In the event that the Examiner finds that an additional fee is required to complete this response, or if a refund is warranted, he is authorized to appropriately credit or debit our Deposit Account No. 22-0261.

In the Office Action the Examiner has rejected claims 2-4, 8, 9 and 13 under 35 U.S.C. §112. By the current amendment, the Applicant has cancelled claim 2 and corrected the Section 112 concerns raised by the Examiner in connection with claims 3, 4, 8, 9 and 13. It is therefore submitted that the Section 112 rejections have been traversed.

In the Office Action, the Examiner has rejected claims 1-14 (all of the pending claims) in view of the patents to Hausmann et al. (the "EPO reference") and in view of the patent to Masabumi (the "Japanese reference"). Reconsideration of the rejections is requested in view of the present amendment and these remarks.

In summary, by the present amendment the Applicant (1) has directed claim 1 -- which previously was directed to an access tool -- to a combination including an access tool and a complementary patch member and (2) presents newly added claims 15 through 19 which clearly distinguish the Applicant's access tool over those tools disclosed in the prior art. Further, the remarks herein demonstrate that the *method* of the present

invention as set forth in claims 8 and 9 is not obvious (and not anticipated) in view of the prior art.

1. The Examiner's Rejection of Claims under §102(a) and 103

In the Office Action the Examiner rejected claims 1-5, 7, 8 and 11-14 under 35 U.S.C. §102 in view of the Haussmann et al patent (hereinafter the "EPO patent"). Claims 1-8, and 11-14 were rejected under 35 U.S.C. §102 in view the Japanese reference. The patent to Freudner (the "German patent") is also cited as relevant prior art. Claims 9 and 10, which were further directed to providing patches for the holes drilled with the tool that was disclosed were rejected under 35 U.S.C. §103 in view of the EPO reference or the Japanese reference.

In response to the rejection, the Applicant has amended independent claim 1 to further recite a patch element that may be received in an annular recess that is formed by the access tool. Support for providing complementary patches with the tool is found at paragraph 21 at page 8 of the patent specification. It is submitted that the combination of patch element and the tool provided together is both novel and, as explained below, is not obvious.

**2. Amended Claim 1, method Claims 8 -9 and Repair Kit Claim 10 are novel and unobvious.**

The Applicant agrees that claim 1 as originally presented did not patentably distinguish over the prior art. In particular, it would appear that Applicant's claimed invention did not adequately distinguish over the embodiment depicted in Fig. 3 of the EPO reference or the tool depicted in the Japanese reference. Since none of the prior art

discloses a patch structure, it is submitted that all rejections under 102 are respectfully traversed.

By the present amendment the Applicant has claimed the tool but in combination with the complementary patch in claims 1 through 7. Claims 8 and 9 are method claims using the tool and patch combination. Claim 10, a claim directed to a tool and repair kit, is now similar to amended claim 1.

It is submitted that the EPO reference does not suggest the combination of the tool and patch nor render this aspect of the invention obvious. The EPO reference discloses a specialty tool that was apparently designed to facilitate the installation of electrical outlets. *See abstract.* There is no suggestion that one would be motivated to use the tool to gain access to a hollow cavity and then subsequently patch the area. If someone was seeking a general tool that could provide temporary access to the interior of a hollow core member, there is no reason why one would select a tool that would leave an annular beveled recess around the access hole. Rather, as discussed below, one would more likely use a drill and keyhole saw. Even if someone selected to create the opening with a hole saw – which is not necessarily a preferred procedure as discussed below--providing an annular ridge around the hole would not be consistent with the objective of accessing the hole unless one specifically contemplates a use for the annular ridge. As explained below, the presence of an annular ridge would be an impediment to later patching the surface.

In analyzing the significance of the prior art to the claimed invention, one must recognize that the prior art is unconcerned with the problem faced by the Applicant – a quick and convenient manner in which to create access to a hollow panel and then patch

the access hole. The EPO prior art forms a hole to receive an opposite electrical outlet part and thus is directed to a different problem than that faced by the Applicants. The German reference is designed to create a cavity that "electric plug points" may be received. *See* German abstract. The Japanese reference discloses boring a hole in a ceiling and a back plate. The reason for boring the hole is not disclosed nor is a technique disclosed for later patching the hole created by the tool.

The German reference, cited but not relied upon by the Examiner, discloses a device that has an outer annular hole saw that completely surrounds an second inner annular hole saw. The cutting surface of the outer hole saw is inclined from the central axis of rotation so that a cavity that is formed by the outer saw will have a beveled edge. It is important to recognize that the angle of the cutting surface of the outer hole saw is not perpendicular to the central axis. As a result the annular cavity that is formed by the outer hole saw will not have a flat seating surface. It is submitted that this difference is significant because the cavity formed by the saw disclosed in the EPO reference will allow a patch to contact the annular beveled cavity only along the circumference of the patch. Because the outer cutting saw is positioned to cut into the surface at an angle of approximately 45 degrees (See Figs. 4 and 7) the resulting cavity does not have a flat annular surface to receive a patch structure. Because the annular recess lacks a planar seating surface for the patch, it would be more difficult to firmly seat a patch.

Not only does the prior art fail to teach the Applicant's invention but the use of the prior art tools for the purpose disclosed by the Applicant is somewhat counterintuitive without the benefit of the hindsight of the invention.

Claims 8 and 9 are directed at a method of accessing a hollow core structure by creating a hole and then patching the hole. The Applicant respectfully disagrees that the claimed method is obvious in view of the cited references. As discussed above, the prior art of record is directed to specialty tools which were designed for specific applications and, apparently, to accommodate specific hardware. For example, both the EPO patent and the German reference (Serial No. 2410 120) are directed to systems designed to create a hole to receive a corresponding electric outlet or plug. The Japanese reference, although not particularly clear, appears to be directed to creating a hole in the ceiling. These references do *not* contemplate drilling a hole and then subsequently patching the hole so that the surface is substantially repaired.

While the Applicant would agree that, in the unlikely event that a user of one of the prior art tools created a hole and then changed his mind and decided to refrain from proceeding with the intended installation, he would then have to patch the hole. However, patching the hole with a patch disclosed by the Applicant is only one of many possible manners to proceed. As discussed herein, if one was faced with the unlikely circumstances of patching a hole formed by the prior art tools, the solution to this problem would not likely be the patch created by the Applicants.

First and foremost, there is no suggestion that, in reality, such circumstances have actually been manifested. It simply does not make sense that one would use the specialized tools disclosed in the cited reference and then refrain from proceeding with the intended installation. However, even assuming these unusual circumstances, one faced with the problem of patching a hole formed by one of the prior art tools, may *inter alia* (1) cut a conventional square hole in the hollow core member to effect the patch

installation, (2) remove the annular beveled edge and then create a complementary circular patch, (3) patch the hole with a circular patch having a diameter of the through hole and initially leave the annular cavity not filled –wherein the annular cavity would then be subsequently filled with joint compound, or (4) may find or create a patch to seat within the annular cavity formed by the tool. Of these choices, it is submitted that the first option would likely preferred because (a) the creation of a circular patch involves more effort and special tools in contrast with a square patch and (b) holes in gypsum drywall are conventionally patched with scrap pieces of gypsum drywall.

In connection with the first rationale, cutting a square out of gypsum can be achieved by using a carpenter's square and simply scoring two lines with razor knife and then snapping the patch off. In contrast, creating a circular patch requires the use of a compass (or suitable template) and then sawing all the way through the gypsum board with a key hole or jig saw. Furthermore, in typical procedures, a square would first be cut out of a larger piece of gypsum board that contained the circular patch. It is submitted that the creation of a circular patch involves considerable more labor and time than the creating of a square patch and requires different and unconventional tools – such as a compass. Accordingly, in absence of the teaching of the invention, the preferred manner of patching the hole would be to form the hole and patch in the shape of a square and proceed as explained in the patent specification.

In connection with the second rationale, gypsum pieces are typically used as patches, because *inter alia* they have a consistent surface with the remainder of the wall and are generally readily available. Because scrap pieces (or commercially available gypsum board drywall) will typically have the same thickness as the wall or member that

is to be accessed, in order for the patch to fit within the hole on the annular ledge without extending above the planar surface, it would have to be shaved down to have the appropriate thickness. In view of this consideration, the procedures outlined in options 1, 2 and 3 would be preferred over the fourth procedure.

Because of the unavailability of a patch, option number 4 would likely involve considerable more time and labor than simply patching the hole in one of the more conventional manners described above. The fourth option, the claimed method of the invention, would *only* be attractive if a patch having the correct dimensions was readily available. However, the patch would not be readily available unless one had the foresight to plan to fill the hole created by the prior art tools.

It is precisely for these reasons that the Applicant's invention -- both the method and combination -- is not obvious. In order to reach the Applicant's invention from the prior art, one would have to disregard the actual intentions and teachings of the prior art. Only if one planned to use the tool as disclosed by the method taught by the Applicant, does the solution disclosed by the Applicant become attractive or "obvious." But this rationale uses hindsight in the classic sense and the argument is therefore impermissible.

Accordingly, central to the invention is the manner in which a complementary patch is provided with the tool and the method of use. The combination and method make the access and subsequent repair of hollow cavity walls quick, easy and inexpensive.

It is submitted that to the extent that the Applicant's solution possibly could result from the problem identified, the problem is only manifested in highly unusual circumstances. It is submitted that *this problem* was not recognized in the prior art. The

problem faced by the inventor was how to create access holes and then easily and quickly repair them. It is submitted however, that the prior art *does not* present those skilled in the art with this problem. While the method and combination with a complementary patch is one of many possible solutions, the solution of the invention would not likely be followed without the benefit of the Applicant's present disclosure.

Furthermore, it is submitted that none of the references of record *suggest* the combination of the tool and a patch element. While the Examiner takes notice of the existence of circular patches having a diameter and thickness that would fit within the holes, the Applicant suggests that such a patch having complementary dimensions of the annular recess, is not disclosed by the prior art. Moreover, gypsum patches commonly used in the prior art would not have a thickness to fit within the annular recess.

In summary, it is submitted that the concept disclosed and claimed is only reached using hindsight, following the blueprint of the inventor. Only with the benefit of knowing the inventors' solution does the invention become apparent. Neither the method nor the combination is obvious because the intent or objective of the prior art tools is not the same as Applicant's – namely, to create a hole to give access to the cavity and then patch it.

**3. The new claims 15 through 17 are novel and unobvious.**

Newly added claim 15 is directed to the Applicant's tool. It is submitted that newly added claim 15 distinguishes over the German patent, the EPO patent and Japanese patent. In connection with the German reference, the structure that corresponds to the Applicant's claimed rebate blades, their manner of attachment, and their relationship with the flange member are distinctly different from the Applicant's invention as set forth in



claim 15. Claim 15 requires that the blade comprise an "L shaped" member including a base and a cutting surface. This structure is absent in the prior art. The structure disclosed in the Japanese reference, which comprises an annular saw, is also distinct from the invention as recited in claim 15. The EPO reference discloses an annular saw as the structure that performs a function that is similar to Applicant's rebate blades.

Newly added claim 16 requires that the inner hole saw have an axial dimension substantially the same as the substrate to be cut through. Support for this claim is found at paragraph 19 of the specification at page 6. Neither the Japanese reference nor the EPO reference discloses providing an inner hole saw that has an axial dimension that is substantially the same as the thickness of the hollow member that is intended to be cut. The dimensions of the axial hole saw disclosed by the German reference cannot be readily ascertained from the disclosure. To the extent that the scale of each of the drawings can be interpreted as being exactly the same, the axial dimension of the hole saw of the German reference is significantly larger than the Applicant's claimed invention. In any event, none of the prior art teaches this relationship which is important when cutting into finished walls having mechanical components such as electrical lines contained therein.

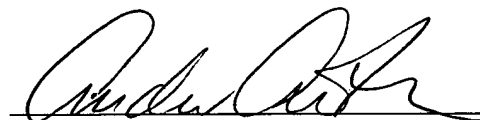
Newly added Claim 17 is both novel and non-obvious because none of the prior art discloses or contemplates an arrangement wherein the flange member does not rotate with the cutting members. Support for this claim is found at paragraph 22 of the specification on page 8.

**CONCLUSION**

It is submitted that the claimed invention, including the device and method, now clearly distinguishes over the prior art. Wherefore, it is submitted that each of the rejections has been traversed and, accordingly, a notice of allowance is respectfully requested.

Respectfully submitted,

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